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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/554,418

10/24/2005

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08/12/2008

EXAMINER

FORTUNA, JOSE A

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

08/12/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/554,418	<b>Applicant(s)</b> FEDRIGONI, GIUSEPPE	
	<b>Examiner</b> José A. Fortuna	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/24/05</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 11-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 11 and 13 the phrase “rotogravure/flexographic” renders the claims indefinite, since it is unclear if the process indicated by the phrase are done in the alternative or the last layer is coated using both process, i.e., rotogravure and flexographic.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 11, 13, 14-15, 19-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wiley et al., US Patent No. 4,409,280.

Wiley et al. teach a decorative sheet in which a substrate, e.g., paper (column 3, lines 25-37), is printed then coated, (the first layer, **21** on figure 2), and then printed with a pigment, (layer **25** on figure 2), see abstract. The pigmented layer contains pearlescent particles, column 5, lines 13-16. Wiley et al. teach also that the coating/printing can be done by any printing, coating techniques, such as rotogravure, flexographic, screen

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printing, etc., column 33-44. It seems that Wiley et al. teach all the elements of the claims or at least the minor modification(s) to obtain the claimed invention would have been obvious to one of ordinary skill in the art.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by De Bastiani et al., US Patent No. 5,571,557 or O'Dell et al., US Patent No. 5,466,511.

Both of the above patents teach a paper having multiple coatings, see abstracts, including a pearlescent coating layer on top of a previous layer, see De Bastiani et al., column 2, lines 23-41 and O'Dell et al., figure 1, and column 3, lines 16-29.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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8. Claims 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Bastiani et al., cited above or Bourdelais et al., US Patent No. 6,544,714 as evidenced by Wiley et al., previously cited, *supra*.

De Bastiani et al. and Bourdelais et al. teach processes of making paper in which a pearlescent/nacreous coating layer is applied to a previously coated base. The base which could be a cellulosic fibrous sheet or polymeric film sheet, i.e., a cellulosic or synthetic paper, see column 1, lines 29-61 of De Bastiani et al. and column 6, lines 36-57 of Bourdelais et al. Both patents teach the use of Mica and nitrocellulose, (as the resin medium of the mica pigment), and teach a range of the paper and coating layers thickness within the claimed range, see De Bastiani et al., column 2, lines 38-41, 3.9 to 5.5 mils of the paper, (99.06 to 139.6 micron ( $\mu$  or  $\mu$ )); 0.5 mils (12.7 $\mu$ ) of the adhesive layer; column 3, lines 25-33, specially step 2 which includes the pearlescent layer, comprising mica a nitrocellulose and a solvent, the latter is removed by evaporation; Bourdelais et al., column 8, lines 16-32; column 10, lines 6-41; column 11, lines 21-35; column 18, lines 3-15 (for the thickness of the base paper); column 20, lines 22-50 (for the use of nitrocellulose); column 31, lines 7-24 (for the thickness of the adhesive layer and the thickness of the base paper). De Bastiani et al. and Bourdelais et al. are silent with respect to the coating with a rotogravure/flexographic device, De Bastiani et al. teach the use of a screen coating/printing. However, coating with a rotogravure/flexographic device would have been obvious to one of ordinary skill in the art, since the screen coating device suggested by De Bastiani et al. is functional equivalent to the rotogravure/flexographic device claimed and it has been held that “[W]here two

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equivalents are interchangeable for their desired function, substitution would have been obvious and thus, express suggestion of desirability of the substitution of one for the other is unnecessary.” In re Fout 675 F. 2d 297, 213 USPQ 532 (CCPA 1982); In re Siebentritt, 372 F.2d 566, 152 USPQ 618 (CCPA 1967). The equivalence is also evidenced by Wiley et al. on column 33-44, where they teach that the coating/printing operation(s) can be done by the use of rotogravure, flexographic or screen printing devices. Therefore, one of ordinary skill in the art would have reasonable expectation of success if the screen printing/coating taught by the primary reference were replaced by the rotogravure/flexographic device as suggested by Wiley et al., *supra*.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of “Method for producing coated paper with pearlescent effect.”

Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A. Fortuna whose telephone number is 571-272-1188. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/José A Fortuna/  
Primary Examiner  
Art Unit 1791

JAF